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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) PDNO. 10003895-1	
I hereby certify that this correspondence is being transmitted via facsimile to 571-273-8300 to the attention of Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450* [37 CFR 1.8(a)]		Application Number 09/691,783	Filed 10/17/2000
on _____ Signature _____		First Named Inventor Keith E. Moore et al.	
Typed or printed name Natali e King		Art Unit 2135	Examiner Leynna Ha
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		 Signature James D. Shaurette Typed or printed name	
<input type="checkbox"/>	applicant/inventor.		
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number 39,833	(509) 624-4276 Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	12/1/05 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of 1 forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Signature: 

**PATENT APPLICATION**  
**DOCKET NO. 10003895-1**

**IN THE**  
**UNITED STATES PATENT AND TRADEMARK OFFICE**

**INVENTOR(S):** Keith E. Moore et al.

**SERIAL NO.:** 09/691,783

**GROUP ART UNIT:** 2135

**FILED:** October 17, 2000

**EXAMINER:** Leynna Ha

**SUBJECT:** Digital Signatures for Tangible Medium Delivery

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**PRE-APPEAL BRIEF A**

**SIR:**

Appellants thank Examiner Ha for the courtesies extended to the undersigned during the telephone interview. Concurrent with the filing of a Notice of Appeal in connection with the above-identified application, the undersigned requests review of the Final Office Action dated September 22, 2005 (hereinafter "the Office Action") of the following issues.

**Positively recited limitations of claim 1 are not disclosed nor suggested by Dwork and the anticipation rejection is improper for at least this reason.**

The Office Action on page 4 states that Col. 6, lines 38-44 of Dwork teaches the claimed *creating the encrypted authentication message which may be decrypted using a recipient's key known to the authorized user*. The identified teachings disclose the user provides a user identifying number n (e.g., credit card number) to the authentication logic which provides the signet pair a, n. Appellants have failed to find any teaching or suggestion in Dwork of creation of an encrypted

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authentication message in addition to the creation of the encrypted content message. During the interview, the Office stated that the signet pair  $a, n$  of Dwork corresponds to the encrypted authentication message. However, Appellants have failed to uncover any teachings that the signet pair is encrypted. In addition, Dwork discloses plural different media 24, 26 of Fig. 1 for communicating the content and signet pair, respectively. Appellants have failed to uncover any teachings in Dwork of the claimed *fixing the encrypted authentication message and the encrypted content message onto the tangible medium* as further defined in claim 1. The Office relies upon teachings in cols. 6 and 7 as allegedly disclosing the claimed fixing. However, the "additional information" of col. 6, lines 27-28 is void of disclosing the claimed encrypted authentication message. There is no evidence whatsoever that the "additional information" is encrypted at all. The teachings in col. 7 merely refer to *distribution of content* and fail to disclose or suggest *fixing an encrypted authentication message in addition to the encrypted content message*.

Further, the claimed allowing the *recipient to obtain the content decryption key if a valid reply based upon the decrypted authentication message has been received* is not disclosed nor suggested by the prior art. The Office relies upon the teachings in cols. 6-7 in support of the rejection. However, lines 38-39 of col. 6 and lines 55-56 of col. 7 disclose producing an authentication signal  $a$  in response to receiving a user number  $n$  to produce a digital signal pair  $a, n$ . Dwork is void of any teaching or suggestion that the *user number  $n$  is a valid reply based upon a decrypted authentication message*. Further, the user provides number  $n$  which is used to generate the signet pair  $a, n$  which was identified as allegedly disclosing the claimed encrypted authentication message. The teachings of cols. 6-7 are contrary to an interpretation that the signet pair discloses an encrypted authentication message. Dwork merely discloses that value  $a$  is produced in response to a user identifying number  $n$  with absolutely no teaching or suggestion that the user identifying number is based upon a decrypted authentication message as claimed.

With reference to the Office's response to Appellants' arguments on page 2 of the Action, Appellants respectfully submit any reliance upon inherency is inappropriate. More specifically, limitations of the claims have not been demonstrated to necessarily flow from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

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At least the above recited imitations of claim 1 are not disclosed nor suggested by the prior art and Appellants respectfully submit the application is in condition for allowance for at least the above-mentioned reasons.

**Positively recited limitations of claim 10 are not disclosed nor suggested by Dwork and the anticipation rejection is improper for at least this reason.**

Referring to independent claim 10, the *article comprises a tangible medium and an encrypted authentication message in addition to the encrypted content message both fixed on the tangible medium.* Dwork discloses separate media 24, 26 comprising an encrypted content distribution medium and a signet distribution medium, respectively. Dwork fails to disclose the encrypted content message and encrypted authentication message fixed on a tangible medium as claimed. The Office recites teachings in col. 7, lines 25-40 as allegedly disclosing the claimed encrypted authentication message. Applicants respectfully disagree. More specifically, the identified teachings merely provide that encrypted content is distributed along with N and whatever other values are required to be stored with the content. *N and the other values are not disclosed as being encrypted nor are they disclosed as comprising an authentication message.* Further, Dwork is void of teaching or suggesting *decryption of the encrypted authentication message using a recipient's key or the recipient using the decrypted authentication message to send a valid reply to the sender.* These positively claimed limitations of claim 10 are not disclosed by the prior art, nor rendered inherent and claim 10 is allowable.

**Positively recited limitations of claim 19 are not disclosed nor suggested by Dwork and the anticipation rejection is improper for at least this reason.**

It is stated on page 8 of the Action that teachings in cols. 6 and 11 disclose the claimed receiving. Applicants respectfully disagree. More specifically, the teachings in col. 6, lines 27-37 merely disclose that encrypted content and "additional information" are stored. The receiving of claim 19 recites the receiving the *tangible medium having an encrypted authentication message and an encrypted content message.* The teachings of col. 6 are void of any teaching or suggestion of the additional information being encrypted and are void of the claimed *encrypted authentication message fixed on the tangible medium having the encrypted content*

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*message*. Further, the teachings in col. 11 refer to a variation of the extrication function. However, there is no teaching of performing the extrication function to decrypt the additional information or any other encrypted data which is fixed to the tangible medium having the encrypted content message thereon. The extrication function is disclosed at col. 7, lines 64+ as being performed upon the signet pair, however, the signet pair is not fixed to the medium to which the encrypted content message is fixed as positively defined in claim 19. Dwork is void of disclosing or suggesting the tangible medium having the encrypted authentication medium and encrypted content message fixed thereon.

At page 8 of the Action, the Office relies upon the teachings of col. 6, lines 38-49 referring to the claimed using of the recipient's key. However, the identified teachings of Dwork refer to the user providing a user number *n* and the system 12 generating the signet pair *a, n* using the user number *n*. There is no teaching or suggestion that the *user number n is a recipient's key or that such is used to decrypt any data let alone the specifically claimed encrypted authentication message as positively claimed*.

Claim 19 also recites *creating a valid reply using the decrypted authentication message*. The Office identifies the teachings in col. 7, lines 55-56 in support of the rejection. However, the teachings in col. 7 refer to the system 12 providing the authorization signal value *a* responsive to the user number *n*. Dwork is void of disclosing or suggesting *the signet a, n is created using any decrypted information let alone the claimed decrypted authentication message as positively claimed*. Further, authorization service center 12 of Dwork provides the signet *a, n* and it is non-sensical to interpret any teachings of entity 12 as disclosing or suggesting creating a *valid reply using a decrypted authentication message which is provided using a recipient's key*. Claim 19 is allowable for this additional reason.

Further, claim 19 recites *sending the valid reply to the sender*. The Office has failed to identify any teachings which allegedly disclose the claimed sending and the limitations are not disclosed nor suggested by Dwork.

Positively-recited limitations of claim 19 are not disclosed nor suggested by Dwork, nor rendered inherent and the anticipation rejection is in error.

Positively recited limitations of claim 27, 28, 29 are not disclosed nor suggested by

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**Dwork and the anticipation rejection is improper for at least this reason.**

The claims recite in varying degrees of specificity fixing both the encrypted authentication message and the encrypted content message onto the same medium (claim 27), comprising a single fixed tangible medium (claim 28) and a compact disc (claim 29). The Office on page 9 of the Office Action relies upon teachings of cols. 6 and 7 in support of the rejection of claims 27-29. However, the teachings in col. 6, lines 25-35 merely disclose storage of encrypted digital content along with N and "additional information." There is no evidence of record that N or the "additional information" are encrypted. Nor is there any evidence of record that N or the additional information may be used to base a valid reply which allows the authorized recipient to obtain the content decryption key. In addition, the teachings in col. 7, lines 25-29 relied upon by the Office merely refer to generic distribution teachings void of any disclosure of fixing both the encrypted authentication message and the encrypted content message onto the same medium.

The Office in the response to Appellants' arguments states on page 2 of the Action that Dwork teaches writing encrypted content onto different media. As set forth above, Dwork fails to disclose or suggest fixing both an encrypted content message and encrypted authentication message onto the same medium.

Numerous positively-recited limitations of claim 27-29 are not disclosed nor suggested by Dwork, nor rendered inherent and the anticipation rejection is in error.

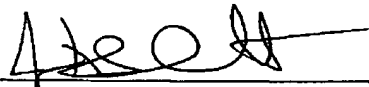
**Conclusion**

Appellants respectfully request reconsideration of at least the above-identified claim rejections and allowance of the respective claims.

Respectfully submitted,

Keith E. Moore  
Amnon Silverstein

By:

  
\_\_\_\_\_  
James D. Shaurette  
Reg. No. 39,833  
Date: 12/1/05

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**PATENT APPLICATION  
DOCKET NO. 10003895-1**

**IN THE  
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**INVENTOR(S):** Keith E. Moore et al.

**SERIAL NO.:** 09/691,783

**GROUP ART UNIT:** 2135

**FILED:** October 17, 2000

**EXAMINER:** Leynna Ha

**SUBJECT:** Digital Signatures for Tangible Medium Delivery

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**INTERVIEW SUMMARY**

**SIR:**

Appellants wish to thank the Examiner for the courtesies extended to the undersigned during the telephone interview. Appellants and the Examiner discussed the rejections of claims 1, 10, 19, and 27-29. No agreement was reached regarding the patentability of any pending claim. Details regarding the specific discussions of the claims are set forth in the Response filed July 7, 2005 and the Pre-Appeal Brief which accompanies the Notice of Appeal filed herewith.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is

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Interview Summary A*


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available for telephone consultation at any time during normal business hours  
(Pacific Time Zone).

Respectfully submitted,

Keith E. Moore  
Amnon Silverstein

By:



James D. Shaurette

Reg. No. 39,833

Date: 12/1/05

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Interview Summary A